



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,860	04/27/2001	Brian J. Franzene	FRAN-002	1370

7590 05/29/2003
Michael S. Neustel
2534 South University Drive, Suite No. 4
Fargo, ND 58103

EXAMINER

KUHNS, ALLAN R

ART UNIT PAPER NUMBER

1732

DATE MAILED: 05/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/844,860

Applicant(s)
FRANZENE

Examiner
KUHN S

Group Art Unit
1732

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on MARCH 17, 2003

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above claim(s) 1-8 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 9-12 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

Art Unit: 1732

1. Applicant's election with traverse of Group II, claims 9-12 in Paper No. 3 is acknowledged. The traversal is on the ground(s) that both the apparatus and method claims pertain to the same subject matter. This is not found persuasive because the subject matter pertaining to the apparatus or system involves structure while the subject matter pertaining to the method involves manipulative steps.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 3.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by White (5,237,520).

White discloses the basic claimed method of producing a custom insole for footwear including

(1) taking measurements of a foot, (2) creating a foot profile or foot sizing information, (3) transferring the foot profile or foot sizing information to a manufacturing station or footwear production facility (column 3, lines 41-42), and (4) producing a custom insole (column 3, line 45) from the foot profile or foot sizing information.

Art Unit: 1732

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over White.

White discloses the aspect of transferring information concerning the foot by a computer network at column 3, lines 20-21. It would have been obvious to one of ordinary skill in the art to use a global network in order to survey all available lasts, as recommended by White at column 3, lines 34-41.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over White as applied to claim 9 above, and further in view of Gee. Gee discloses the aspect of injecting a liquid resin which forms an inner sole portion upon a positive impression or last. It would have been obvious to one of ordinary skill in the art to incorporate this aspect taught by Gee into the method of White in order to shape the inner sole portion in a customized manner. White teaches or suggests the aspect of generating a positive foot impression, and removing a molded article after the molding material has hardened or "set" is well known and would have been obvious to one of ordinary skill in the art in order to ensure that the molded article will retain its shape upon removal from the mold.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over White in view of Gee as applied to claim 10 above, and further in view of Dunham et al. Dunham et al. teach or

Art Unit: 1732

suggest the aspect of generating a positive foot impression by manipulating a series of probes or pins to reflect the positive impression and thereafter resetting the probes or pins. It would have been obvious to one of ordinary skill in the art to incorporate this aspect taught by Dunham et al. into the method of White because the technique of Dunham et al. represents an established technique of providing a customized foot profile.

8. Clause (a) of claim 9 appears to lack the term "of".
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Kuhns whose telephone number is (703) 308-3462. The examiner can normally be reached on Monday to Thursday from 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino, can be reached on (703) 308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Allan R. Kuhns
ALLAN R. KUHNS
PRIMARY EXAMINER AU 1732

5-27-03